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In the Supreme Court of the United States

OCTOBER TERM, 1952

No. 118

LANOLIN PLUS COSMETICS, INC., PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS, AND BOTANY MILLS, INC.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF IN OPPOSITION FOR THE RESPONDENT COMMISSIONER OF PATENTS

OPINIONS BELOW

The findings of fact, conclusions of law and opinion of the District Court for the District of Columbia (R. 12-14) are not reported. The *per curiam* opinion of the Court of Appeals (R. 44-45) is reported at 196 F. 2d 591.

JURISDICTION

The judgment of the Court of Appeals was entered on April 17, 1952 (R. 46). The petition for a writ of certiorari was filed on June 10, 1952. The

jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).[1]

QUESTIONS PRESENTED

1. Whether petitioner is entitled to the registration in the Patent Office of a trade-mark which is merely descriptive of the quality of an ingredient of the goods for which it is used.

2. Whether petitioner is entitled to the registration of a trademark, the registration of which is expressly forbidden by law, on the ground that similar marks have been registered in the Patent Office.

STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905, 33 Stat. 724, 725-6, 15 U. S. C. 85(b), provides in pertinent part as follows:

> No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> (b) * * * Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the

[1] Section 18 of the Trade-Mark Act of 1905, 33 Stat. 724, 729, 15 U.S.C. 98, also relied on by petitioner, was repealed by Section 39 of the Act of June 25, 1948, 62 Stat. 869, 992.

character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act * * *.

STATEMENT

Disclaiming any right to the word lanolin alone (R. 32, 33), petitioner applied for registration of the combination "Lanolin Plus" as a trade-mark for cosmetics and soap under the Trade Mark Act of 1905. Respondent Botany Mills, Inc., filed oppositions on the ground that the term "Lanolin Plus" was descriptive. The Examiner of Interferences first sustained Botany Mills' opposition to registration of "Lanolin Plus" for face cream and related products on July 28, 1947 (R. 32) and this decision was affirmed by the Assistant Commissioner on March 16, 1948 (R. 33). A different Examiner of Interferences sustained the opposition to the registration for soap on March 15, 1950 (R. 37-39) and was in turn affirmed by a different Assistant Commissioner of Patents (R. 40). Petitioner then instituted a proceeding in the United States District Court for the District of Columbia under R. S. 4915, 35 U. S. C. 63 (R. 1-10). The District Court agreed with the Patent Office that the words "Lanolin Plus" were descriptive and not entitled to registration as a trade-mark (R. 12). The Court of Appeals affirmed (R. 44-45).

ARGUMENT

1. Section 5(b) of the Trade-Mark Act of 1905, *supra,* expressly forbids the registration of a trade-mark which is merely descriptive of the

goods with which it is used. In the instant case, the Examiners of Interferences (R. 32-33, 37-39), the Assistant Commissioners of the Patent Office (R. 33-36, 40-42), and the District Court (R. 13) all found that the mark "Lanolin Plus" is merely descriptive for cosmetics and soaps, and rejected petitioner's contention that the term is fanciful. These findings, which were implicitly accepted by the court below (R. 44-45), are plainly correct. Manifestly, lanolin describes the ingredient and "plus" is an enthusiastic term descriptive of purity, quality or efficacy (R. 23-24, 26-30). In the words of the Assistant Commissioner, it indicates that "the goods contain a superior grade of lanolin * * * a mere laudatory expression" (R. 35). Cf. *Burmel Handkerchief Corp.* v. *Cluett, Peabody & Co.*, 127 F. 2d 318 (C.C.P.A.); *Franklin Knitting Mills* v. *Fashionit Sweater Mills*, 297 Fed. 247 (S.D.N.Y.), affirmed, 4 F. 2d 1018 (C.A. 2).

The decisions below denying registration of petitioner's mark [2] are supported by the holdings of this Court, which establish that under the 1905 Act no one can preempt descriptive terms and thereby gain a monopoly to fence out competitors who have equal rights to sell the products. *Warner & Co.* v. *Lilly & Co.*, 265 U. S. 526, 528; *Standard Paint Co.* v. *Trinidad Asphalt Co.*, 220 U. S. 446, 453;

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[2] As the Court of Appeals noted (R. 45, fn. 1), Section 2(e) of the Trade-Mark Act of 1946, 60 Stat. 429, 15 U.S.C. 1052(e), is not applicable to a proceeding pending before the Patent Office before July 5, 1947. Act of July 5, 1946, Sec. 46(a), 60 Stat. 444; see also *Magic Foam Sales Corp.* v. *Mystic Foam Corp.*, 167 F. 2d 88, 90 (C.A. 6).

Elgin Nat'l Watch Co. v. *Illinois Watch Case Co.*, 179 U. S. 665, 673; *Canal Co.* v. *Clark*, 13 Wall. 311, 323. The Patent Office represents the public interest (*Tomlinson of High Point* v. *Coe*, 123 F. 2d 65 (C.A. D.C.); *Ippolito* v. *Nancy Ann Dressed Dolls*, 184 F. 2d 201, 203 (C.C.P.A.)) and that interest, as declared by Congress in the statute, precludes the registration of a descriptive mark. There is no semblance to the arbitrary or fanciful (see *Hamilton Shoe Co.* v. *Wolf Brothers*, 240 U. S. 251, 256) in the term "Lanolin Plus", as applied to cosmetics and soap with lanolin as an ingredient (R. 18). It is neither suggestive nor figurative. See *General Shoe Corp.* v. *Rosen*, 111 F. 2d 95, 98 (C. A. 4).

At the outset of a promotional campaign, "Lanolin Plus" would hardly signify the producer rather than the product, its qualities, ingredients, and characteristics. *Kellogg Co.* v. *Nat. Biscuit Co.*, 305 U. S. 111, 118; *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 543. To register the mark would encourage the misconception that others have no right to sell lanolin cosmetics and soaps. *Singer M'f'g Co.* v. *June M'f'g Co.*, 163 U. S. 169, 185-186; *United Shoe Mach. Corp.* v. *Compo Shoe Mach. Corp.*, 56 F. 2d 292 (C. C. P. A.). But petitioner has no exclusive right to sell lanolin products. See *Durable Toy & Novelty Corp.* v. *J. Chein & Co.*, 133 F. 2d 853, 854 (C. A. 2), certiorari denied, 320 U. S. 211. A mark will not be registered if the courts would decline to protect it. *Mont-O-Min Sales Corporation* v. *Wyeth, Incorporated*, 92 F.

Supp. 150, 155 (W. D. Mo.). And "no sign or form of words can be appropriated as a valid trade mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose." *Elgin Nat'l Watch Co.* v. *Illinois Watch Case Co.,* 179 U. S. 665, 673; see also *Standard Paint Co.* v. *Trinidad Asph. Co.,* 220 U. S. 446, 453; *Canal Company* v. *Clark,* 13 Wall. 311, 323. A descriptive word cannot form the dominant part of a mark. *National Nugrape Co.* v. *Judge & Dolph,* 154 F. 2d 521 (C.C.P.A.); *West Disinfecting Co.* v. *Lan-O-Sheen Co.,* 163 F. 2d 566, 569 (C.C.P.A.). No prior course of conduct in the Patent Office recognizing "plus" combinations would justify a deviation from the statutory prohibition against registration of descriptive marks. *Application of National Recreation Ass'n,* 181 F. 2d 221 (C.C.P.A.); cf. *Houghton* v. *Payne,* 194 U. S. 88, 100; *Schafer* v. *Helvering,* 83 F. 2d 317, 320 (C.A. D.C.), affirmed, 299 U. S. 171.

Petitioner's claim that it was entitled to registration of its trade-mark because the Patent Office has registered a number of similar marks was properly disposed of by the court below in its observation (R. 45):

> But the fact that the [Patent] Office has erred in those instances does not mean that it should err in this one.

In view of the fact that the statute expressly forbids the registration of marks that are merely de-

scriptive, it may be reasonably assumed that the Patent Office, in the prior matters mentioned by petitioner, reached factual determinations that the marks there considered were not merely descriptive of the goods involved. Those factual determinations would clearly not bind the Patent Office to make similar determinations in future cases involving different marks and different goods. Nor would those factual determinations amount to an administrative interpretation of the statute that descriptive marks may be registered. The express prohibition of the statute against the registration of descriptive marks, together with the public policy against the fostering of monopoly, would render clearly erroneous any administrative interpretation authorizing the registration of such marks and leave it entitled to no weight whatever. Moreover, in situations where the standards for applying trade-mark statutes set up by the Patent Office are later determined by it to be broader than the statutes reasonably permit, the courts will uphold the decisions of that Office in correctly revising those standards. *White House Milk Products Co.* v. *Dwinell-Wright Co.*, 111 F. 2d 490, 492-493 (C.C.P.A.); *Application of National Recreation Ass'n*, 181 F. 2d 221, 222 (C.C.P.A.). And this Court will decline to apply an unreasonably broad interpretation of a patent statute by that Office. *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147. Thus, petitioner has no vested right to have the Patent Office follow its prior determinations.

2. Petitioner contends that the refusal of the

Patent Office to register its trade-mark deprived it of its property without due process of law (Br. 9), and denied it the equal protection of the laws (Br. 14). These contentions are patently without substance. Petitioner is entitled to the privilege of registration only if Congress has authorized it (Cf. *Houghton* v. *Payne*, 194 U. S. 88, 100). Here, Congress has expressly forbidden the registration of a trade-mark such as petitioner's which is merely descriptive of the goods with which it is used. Moreover, even if Congress had permitted registration of a trade-mark such as that here involved, it would confer no substantive right on petitioner, but only a procedural advantage. See *Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U. S. 315, 322; *Best & Co.* v. *Miller*, 167 F. 2d 374, 376 (C. A. 2), certiorari denied, 335 U. S. 818. Hence, it is difficult to see how the failure of the Patent Office to register the trade-mark could deprive petitioner of property or property rights. The equal-protection-of-the-laws clause of the Fourteenth Amendment does not, of course, apply to the Federal Government,[3] and there is obviously no such discriminatory treatment as could possibly ground a claim of denial of due process, even if that clause of the Fifth Amendment were otherwise applicable.[4]

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[3] *Hirabayashi* v. *United States*, 320 U.S. 81, 100; *Detroit Bank* v. *United States*, 317 U.S. 329, 331; *Sunshine Coal Co.* v. *Adkins*, 310 U.S. 381, 401; *Currin* v. *Wallace*, 306 U.S. 1, 14; *Steward Machine Co.* v. *Davis*, 301 U.S. 548, 584; *Truax* v. *Corrigan*, 257 U.S. 312, 332.

[4] The ruling of the court below does not estop petitioner from seeking registration of its mark under Section 1(b) of the Act of March 19, 1920 (41 Stat. 533), which provided for the

CONCLUSION

Petitioner's mark, which merely specifies an ingredient and adds a laudatory suffix, is plainly not entitled to registration. The decision of the court below is clearly correct, and further review is not warranted. It is respectfully submitted, therefore, that the petition for a writ of certiorari should be denied.

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JULY, 1952.

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registration of marks not registrable under the proviso of Section 5 of the 1905 Act, and "which have been in bona fide use for not less than one year in interstate or foreign commerce." *Cf. Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U.S. 315.

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